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8 IN THE UNITED STATES DISTRICT COURT

9 FOR THE NORTHERN DISTRICT OF CALIFORNIA

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11 TYCO HEALTHCARE GROUP LP d/b/a
VNUS MEDICAL TECHNOLOGIES

No. C-08-3129 MMC

12 v. Plaintiff

**ORDER DENYING DEFENDANTS'
MOTION FOR SUMMARY JUDGMENT
THAT ASSERTED '084 CLAIMS ARE
OBVIOUS**

13 BIOLITEC, INC., et al.,

14 Defendants

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17 Before the Court is defendants' "Motion for Summary Judgment that the Asserted
18 '084 Claims are Obvious," filed June 25, 2010. Plaintiff Tyco Healthcare Group LP has filed
19 opposition, to which defendants have replied. Having read and considered the papers filed
20 in support of and in opposition to the motion, the Court rules as follows.¹

21 Plaintiff alleges defendants have infringed the claims of U.S. Patent No. 6,258,084
22 ("084 Patent"). By the instant motion, defendants argue they are entitled to summary
23 judgment on their respective counterclaims that Claims 1, 2, 18, 19, 20, and 21 of the '084
24 Patent are obvious. In particular, defendants argue that said claims are obvious in light of
25 an October 1997 abstract authored by K.S. Sagoo ("Sagoo Abstract") when read in
26 conjunction with U.S. Patent No. 6,165,172 ("172 Patent"). According to defendants, the
27 Sagoo Abstract teaches the "compressing" and/or "exsanguinating" steps in Claims 1, 2,

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1By a Clerk's notice filed July 22, 2010, the matter was taken under submission.

1 18, 19, 20, and 21,² while the specification of the '172 Patent teaches the remaining steps.

2 A patent claim is obvious "if the differences between the subject matter sought to be
 3 patented and the prior art are such that the subject matter as a whole would have been
 4 obvious at the time the invention was made to a person having ordinary skill in the art to
 5 which said subject matter pertains." See 35 U.S.C. § 103(a). "Whether the claimed subject
 6 matter would have been obvious at the time of invention to one of ordinary skill in the
 7 pertinent art is a question of law based on underlying facts." Trimed, Inc. v. Stryker Corp.,
 8 608 F.3d 1333, 1341 (Fed. Cir. 2010). "The relevant factual inquires include . . .
 9 (1) the scope and content of the prior art; (2) the differences between the claimed invention
 10 and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary
 11 considerations." Id. (internal quotation and citation omitted).

12 "Because patents are presumed valid, a moving party seeking to invalidate a patent
 13 at summary judgment must submit such clear and convincing evidence of facts underlying
 14 invalidity that no reasonable jury could find otherwise." Id. at 1340 (internal quotation and
 15 citation omitted); see, e.g., Knoll Pharmaceutical Co. v. Teva Pharmaceuticals USA, Inc.,
 16 367 F.3d 1381, 1384-85 (Fed. Cir. 2004) (reversing order granting summary judgment on
 17 issue of obviousness, where "evidence adduced did not establish undisputed facts to
 18 support . . . invalidity"). Specifically, summary judgment is appropriate only if the underlying
 19 facts are "not in material dispute, and the obviousness of the claim is apparent in light of
 20 [those facts]." See KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 427 (2007).

21 Here, construing the evidence in the light most favorable to plaintiff, the Court finds
 22 summary judgment is not appropriate. See Mazzari v. Rogan, 323 F.3d 1000, 1005 (Fed.
 23 Cir. 2003) (holding, where party seeks summary judgment on issue of obviousness, district

25 ²The method set forth in Claim 1 includes the step of "injecting a tumescent fluid
 26 solution into selected tissue that is in contact with the treatment site to cause the tissue to become
 27 tumescent and compress the hollow anatomical structure at the treatment site to a compressed size." See '084 Patent, col. 17, ll. 63-67 (emphasis added). Claims 2, 18, 19,
 28 20 and 21 include a similar compression step. Claims 2 and 19 also require the compression be sufficient "to exsanguinate blood from the hollow portion of the hollow anatomical structure at the treatment site." See '084 Patent, col. 18, ll. 5-9; id., col. 19, ll. 36-41.

1 court must "construe the facts in the light most favorable to the non-movant"). In particular,
 2 plaintiff has submitted evidence that, if credited by the trier of fact, would support a finding
 3 that a person skilled in the art would not understand the Sagoo Abstract to teach the
 4 "compressing" and/or "exsanguinating" steps disclosed in the '084 Patent. (See Sarkar
 5 Decl. ¶ 6; Lisson Decl. Ex. 17 at 47,³ Ex. 62 at 22-23); Trimed, 608 F.3d at 1341 (holding
 6 "what a reference teaches" is a "question[] reserved for the finder of fact").

7 Further, even assuming the Sagoo Abstract teaches the "compressing" and/or
 8 "exsanguinating" steps, plaintiff has submitted evidence that, if credited by the trier of fact,
 9 would support a finding that persons skilled in the art would not have had a reason or
 10 motivation to combine the procedure set forth in the Sagoo Abstract with the method
 11 disclosed in the '172 Patent. (See Sarkar Decl. ¶¶ 7-9; Lisson Decl. Ex. 17 at 20, 41, 50,
 12 52, Ex. 62 at 18-21, 28, Ex. 94); KSR, 550 U.S. at 418 (holding district court, when
 13 considering whether patent claim is obvious, must "determine whether there was an
 14 apparent reason to combine the known elements in the fashion claimed by the patent at
 15 issue"); see also Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332,
 16 1337 (Fed. Cir. 2005) (holding that because inventions "typically are new combinations of
 17 existing principles or features," finding of obviousness requires evidence of "motivation to
 18 combine the elements already present in the prior art").

19 Accordingly, the motion is hereby DENIED.

20 **IT IS SO ORDERED.**

21 Dated: August 3, 2010


 22 MAXINE M. CHESNEY
 23 United States District Judge

24 ³Exhibit 17 is an expert report prepared by Warren S. Grundfest, M.D. ("Dr.
 25 Grundfest") submitted in support of plaintiff's opposition. In a declaration filed after the
 26 completion of briefing, and under penalty of perjury, Dr. Grundfest "reaffirmed the opinions
 27 and bases for the opinions expressed in [his] report." (See Grundfest Decl. ¶¶ 1, 2.)
 28 Defendants' objection to the timeliness of the declaration is overruled. See Gache v. Town of Harrison, 813 F. Supp. 1037, 1052 (S.D.N.Y. 1993) (affording party who filed unsworn
 expert reports to oppose motion for summary judgment leave to cure defect by filing
 declarations from experts after briefing was complete; finding defendant was not prejudiced
 by late-filed declarations because defendants "were already fully cognizant of the opinions
 of plaintiff's experts").